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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Barron)	Art Unit: 3751
)	
Serial No.: 10/783,567)	Examiner: Bastianelli
)	
Filed: February 20, 2004)	DP-311107
)	
For: SOLENOID VALVE WITH VALVE HOUSING)	July 25, 2007
HAVING INTERNAL PORTS, WINDING BAY,)	750 B STREET, Suite 3120
VALVE SEAT, AND BALL RETAINER)	San Diego, CA 92101
)	

REPLY BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This Reply Brief responds to the Examiner's Answer dated July 16, 2007, attempting to shore up the rejections with further explanations that continue to miss the point.

Which is, that Teranishi does not do what the examiner alleges it does, and that as a consequence even if the references were combined as proposed Claim 1 would not result. More specifically, the examiner continues to insist (Answer, page 3, line 14 under "Grounds of Rejection") that Tenerashi teaches a rod 25 that is distanced from a ball 17 in the deenergized position, citing col. 5, lines 39-43, when the exact obverse of this allegation is true of Teranishi for reasons explained in the Appeal Brief. This means that the rejection of Claim 1 is reversible for at least two reasons: (1) Tenerashi teaches away from the claims, and (2) a finding of fact that has been used to reject Claim 1 is wrong because the "fact" alleged to be in the reference is simply not there - its opposite is.

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Sensing the bankruptcy of the *prima facie* case, the Examiner subtly shifts ground on page 4, last paragraph of the Answer, now representing that he is using Tenerashi for the proposition that "the rod is separated from the ball *when the ball is in the closed position*" (emphasis mine). First, this falsely represents what the rejection on page 3 of the Answer actually alleges. Second, the belated attempt to conflate "deenergized" with "closed" is too clever by half, because Claim 1 requires that in the deenergized configuration, the ball is against the valve seat and the rod is distanced from the ball, and in neither Okazaki nor Tenerashi does this occur - in Okazaki's deenergized state the valve is closed but the rod and ball contact each other, and likewise in Tenerashi's deenergized state the rod and disc contact each other. It is thus mysterious how two references, both of which teach that in a deenergized state rod and ball/disc contact each other, somehow, when combined, arrive at a claim in which the opposite is recited.

Consequently, the first problem with the Answer is that it represents a classic case of picking and choosing isolated teachings from the prior art (*viz.*, Tenerashi teaching separation in the closed configuration) while ignoring teachings away (*viz.*, the fact that Tenerashi is energized, not deenergized, in the closed configuration). This leads to the second problem, namely, that as a consequence of not considering the references as a whole, the proffered suggestion to combine (to reduce hysteresis as taught in Tenerashi, see Answer, page 3, line 17) bears no relevance to Okazaki and moreover cannot be shoehorned into Okazaki because the rationale for combining occurs only when Tenerashi is energized, not when it is deenergized.

As to the utter failure to explain where the claimed range is in the references, the Answer merely decrees that "the rod is seen to move away from the ball by at least .1mm at some point *when deenergized*", Answer, page 5, line 3 (emphasis mine). It indeed "is seen" but only by the Examiner, who cannot produce any teaching of this allegation in a reference in which it is entirely possible that the separation distance is

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under .1mm. That the Examiner "sees" untaught things in references is no substitute for actual evidence, and because a proponent of unpatentability must produce evidence of it, KSR Int'l Inc. v. Teleflex, Inc., ___ S. Ct. ___ (2007), the rejection runs afoul of Supreme Court case law. Furthermore, it is telling that the Examiner reverts from the rationalization discussed above grounded in terms of "closed configurations" to the initial allegation incorrectly grounded in terms of deenergized states that underpin the rejections.

Turning to the rebuttal on page 5, first full paragraph of the Answer related to Claim 7, it is fitting that the Answer concludes with an obvious prevarication, alleging that Appellant "is wrong that the valve seat 30 [of Gaylord] has been used as the deformable rib". Perhaps the conferees failed to review page 4, line 3 of the Answer: "Gaylord discloses a deformable rib 30". Something is indeed "wrong" here, but it is not Appellant's possibly ingenuous taking of the rejections at their word.

Since nothing in Gaylord mentions that its valve seat can be a rib, modifying the rib of Okazaki in accordance with what Gaylord teaches about valve seats is not suggested in the references. That the examiner has elected to refer to an apple as an orange by simply decreeing that Gaylord's valve seat is a rib does not vitiate the legal requirements of properly making a *prima facie* case. If the references were to be combined in accordance with what they teach, as they are supposed to be, combining Gaylord with Okazaki et al. would result in a deformable valve seat as taught by Gaylord in the structure of Okazaki et al., not a deformable rib with separately recited valve seat as set forth in Claim 7.

As to the remainder of the Answer, the Examiner helpfully demonstrates, using a list of unrelated elements from the references that are insulated from the actual teachings of the references, that he indeed is picking and choosing isolated teachings and cramming them together in unsuggested ways to arrive at the rejections.

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Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

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